

## REMARKS

Claims 1-30 presently stand rejected in the instant application. Claims 21, 22, 29, and 30 are canceled herein. Claims 1-20 and 23-28 remain pending. Claims 1, 6, 11, 17, 20, and 26 are amended herein. Entry of this amendment and reconsideration of the pending claims are respectfully requested.

### *Specification Amendments*

Applicants have amended paragraphs [0053] and [0057] to correct minor typographical errors. These corrections are believed to introduce no new matter.

### *Claim Rejections – 35 U.S.C. § 102*

#### **Claims 1-4 and 7-10**

Claims 1-4 and 7-10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Chen (US 7,069,439).

A claim is anticipated only if each and every element of the claim is found in a single reference. M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the claim.” M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989)).

Claim 1, as amended, currently recites in pertinent part, “...wherein the original portion of firmware comprises a startup portion of one of system management mode (SMM) firmware code and platform management interrupt (PMI) firmware code...” Applicants respectfully assert that Chen fails to disclose this expressly recited limitation. In fact, the Office Action reiterates this in the rejection of claim 6 by stating, “Chen does not specifically disclose the usage of platform management interrupt (PMI) firmware and system management mode (SMM) firmware.” Office Action, mailed 9/5/2006, p. 19. The Office Action then asserts that Zimmer (US Pub. 2004/0073806) discloses this

missing element. However, as will be discussed below, 35 U.S.C. 103(c) prevents Zimmer from being relied upon to preclude patentability.

Consequently, Chen fails to disclose each and every element of amended claim 1, as required under M.P.E.P. § 2131. Accordingly, Applicants request that the instant §102 rejection of claim 1 be withdrawn.

#### *Statement of Common Ownership*

The present patent application and US Pub. 2004/0073806 to Vincent J. Zimmer, were, at the time the invention of the present application was made, owned by or subject to an obligation of assignment to Intel Corporation of Santa Clara, California.

#### *Claim Rejections – 35 U.S.C. § 103*

#### **Claims 5, 11-16, 18-20, and 23-28**

Claims 5, 11-16, 18-20, and 23-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Challener (US Pub. No. 2005/0138393).

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03.

Claim 11, as amended, currently recites in pertinent part, “... wherein the trusted portion of the original firmware configuration includes a startup portion of one of system management mode (SMM) firmware code and platform management interrupt (PMI) firmware code ...” Applicants respectfully assert that both Chen and Challener fail to disclose, teach, or suggest this expressly recited limitation. In fact, the Office Action reiterates this in the rejection of claim 17 by stating, “Chen and Challener does [sic] not specifically disclose the usage of platform management interrupt (PMI) firmware and system management mode (SMM) firmware.” Office Action, mailed 9/5/2006, p. 20. The Office Action then asserts that Zimmer (US Pub. 2004/0073806) discloses this

missing element. However, as will be discussed below, 35 U.S.C. 103(c) prevents Zimmer from being relied upon to preclude patentability.

Thus, the cited references fail to disclose, teach or suggest each and every element of claim 11, as required under M.P.E.P. §2143.03. Independent claims 20 and 26 includes similar nonobvious elements as independent claim 11. Accordingly, Applicants respectfully request that the §103(a) rejections of claims 11, 20 and 26 be withdrawn.

#### **Claims 6, 17, 21, 22, 29, and 30**

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Zimmer (US Application No. 10/268,855). Claims 17, 21, 22, 29, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Challenger and further in view of Zimmer. Claims 21, 22, 29, and 30 have been canceled. However, the limitations of canceled claims 21, 22, 29 and 30 have been incorporated into their respective independent claims.

“Subject matter developed by another person, which qualifies as prior art only under one or more of subsection (e), (f), and (g) of section 102 of this title, **shall not preclude patentability under this section** where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” 35 U.S.C. § 103(c) [**emphasis added**].

Applicants kindly bring to the attention of the Examiner that both Zimmer and the instant application were, at the time the present invention was made, both owned by or under an obligation of assignment to Intel Corporation of Santa Clara, California. Therefore, pursuant to 35 U.S.C. § 103(c), Zimmer may not be relied upon to preclude patentability under § 103(a). Accordingly, Applicants respectfully request that the instant § 103(a) rejections of claims 6 and 17 be withdrawn.

The dependent claims are novel and nonobvious over the prior art of record for at least the same reasons as discussed above in connection with their respective

independent claims, in addition to adding further limitations of their own. Accordingly, Applicants respectfully request that the instant § 102 and § 103 rejections of the dependent claims also be withdrawn.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicants believe the applicable rejections have been overcome and all claims remaining in the application are presently in condition for allowance. Accordingly, favorable consideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to telephone the undersigned representative at (206) 292-8600 if the Examiner believes that an interview might be useful for any reason.

### **CHARGE DEPOSIT ACCOUNT**

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a). Any fees required therefore are hereby authorized to be charged to Deposit Account No. 02-2666. Please credit any overpayment to the same deposit account.

Respectfully submitted,

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